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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,058	11/29/2000	Benjamin N. Truelove	MICR0519	8668
27792	7590	06/08/2005	EXAMINER	
MICROSOFT CORPORATION LAW OFFICES OF RONALD M. ANDERSON 600 108TH AVENUE N.E., SUITE 507 BELLEVUE, WA 98004			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,058

Applicant(s)

TRUELOVE ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Application History***

1. This action is responsive to applicant's Request for Continued Examination, filed on 3/10/2003.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 10/21/2004) has been withdrawn pursuant to 37 CFR 1.114.
3. Applicant has amended claims 1, 8, 13 and 22.
4. Claims 1-23 are pending in the case, claims 1, 13 and 22 are independent claims.
5. Examiner's rejection of claims 1-23, made under 35 USC 102 or 35 USC 103, as being anticipated or unpatentable in view of Russo Borland, "Running Microsoft Word 97", Published by Microsoft Press, Redmond, Washington USA, 1997 as recited in the previous office action (dated 10/21/2004) are withdrawn in view of the amended claims.

**Claim Rejections - 35 USC § 112**

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."*

7. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
8. **Regarding independent claims 1 and 22**, the amendment filed 3/10/2005 adds the following limitations: "simultaneously displaying" (new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
9. **Regarding independent claim 1**, the amendment filed 3/10/2005 adds the following limitations: "the user is able to visually compare" (new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

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10. **Regarding independent claim 13**, the amendment filed 3/10/2005 adds the following limitations: "without applying any of the formats to the portion of text" (new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
11. **Regarding dependent claims 2-12, 14-21 and 23**, the claims are rejected for fully incorporating the deficiencies of the independent claims, and are rejected with the same rationale.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

13. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo Borland, "Running Microsoft Word 97", Published by Microsoft Press, Redmond, Washington USA, 1997. "*Russo Borland*" (herein after

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"Borland") in view of Parker et al. US Patent RE 36,704, filed 11/16/1995, patented 5/16/2000 (herein after "*Parker*").

14. **Regarding independent claim 1**, Borland discloses determining a sample of formats comprising a plurality of formats form a format set, where the format set includes a font set and a color set. Borland discloses the use of format "Styles" in the figure on page 60. The figure discloses a plurality of format styles and related samples. Each style has font and color settings; see Figure 2-5 on page 43 for examples of color and font settings related to styles. Borland discloses identifying a portion of text to be reformatted. Borland recites: *"To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)"* (page 37, second paragraph). Borland discloses reformatting the text and displaying the result in a preview window. Borland discloses reformatted text in a preview window in the figure on page 61.

Borland fails to disclose simultaneously displaying each of the reformatted text portions in live preview windows in order that a user can visually compare how each portion of text will appear in each of the formats. Parker teaches the simultaneous display of text portions for comparison by a user in Figure 6a at reference sign 610 (shown on the right hand side of the figure as four simultaneously displayed previews).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to combine the reformatting of Borland with the

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simultaneous display taught by Parker in order to “*produce user documents with a user selected typeface in a user selected format*” (Parker, column 1, lines 16-17).

15. **In regard to dependent claim 2**, the claim is directed toward a computer readable medium with computer executable instructions. Borland discloses reformatting documents as described above. Borland fails to explicitly describe a computer readable medium with instructions, but Borland describes common computer environment capabilities, like saving files (page 132), creating folders (page 133) and exiting applications (page 150).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to use the teachings of Borland on a computer system, because document format management is typically implemented on a computer system to allow instantaneous document reformatting capabilities.

16. **In regard to dependent claim 3**, Borland discloses selecting a color and font that determines a format set in the first figure on page 43. The user would select the “Ok” button in the dialog window shown in the first figure on page 43 to determine the selected format set.

17. **In regard to dependent claims 4 and 5**, Borland discloses a trained designer defining color schemes (claim 4) and font themes (claim 5). Borland discloses a “*Hiring a Decorator: AutoFormat*” section of his manual, starting on page 35 (second paragraph). Borland also recites: “*Improving the looks of characters means adding decorative touches to the basic appearance of*

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*words—selecting the font name, style, size, and colors*" (page 42, second paragraph).

18. **In regard to dependent claim 6**, Borland discloses a format having a font name, font color and font size in the first figure on page 43.
19. **In regard to dependent claim 7**, Borland discloses a preview window displayed above the document. Borland discloses a preview window dialog box in the figure on page 61. Window's Dialog boxes are displayed above the parent application (in this case the Word document).
20. **In regard to dependent claim 8**, Borland discloses receiving a command to add a custom format in the figure on page 60 (see the "New" button shown in the figure). Borland discloses adding the custom format to the sample of formats. Borland describes the steps to add a custom format (described as "Styles") on pages 826 to 842. Specifically the dialog box on page 830 (the upper figure on the page) shows the basic custom font-specifying tool, where the user would select the "Ok" button to add the custom format to the sample of formats. Borland discloses reformatting the text with the custom format and displaying the reformatted text in the preview window. Borland discloses a custom format (shown as "Invite") used to reformat a section of text, which is displayed in a preview window in the figure on page 834.



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21. **In regard to dependent claim 9**, Borland discloses a user defined custom format. Borland describes the steps for a user to add a custom format (described as "Styles") on pages 826 to 842.
22. **In regard to dependent claim 10**, the claim contains substantially the same subject matter as claim 2, and is rejected with the same rationale.
23. **In regard to dependent claims 11 and 12**, Borland discloses identifying the portion of text to be reformatted by text located adjacent to the cursor (claim 11) or text that has been highlighted (claim 12). Borland recites: *"To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)"* (page 37, second paragraph).
24. **In regard to independent claim 13**, the claim is directed to a system for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
25. **In regard to dependent claim 14**, the claim is directed to a system for performing the method of claim 6, and is rejected with the same rationale.
26. **In regard to dependent claim 15**, the claim is directed to a system for performing the method of claim 4, and is rejected with the same rationale.

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27. **In regard to dependent claim 16**, the claim is directed to a system for performing the method of claim 5, and is rejected with the same rationale.
28. **In regard to dependent claim 17**, the claim is directed to a system for performing the method of claim 7, and is rejected with the same rationale.
29. **In regard to dependent claim 18**, the claim is directed to a system for performing the method of claim 8, and is rejected with the same rationale.
30. **In regard to dependent claim 19**, the claim is directed to a system for performing the method of claim 9, and is rejected with the same rationale.
31. **In regard to dependent claim 20**, the claim is directed to a system for performing the method of claim 11, and is rejected with the same rationale.
32. **In regard to dependent claim 21**, the claim is directed to a system for performing the method of claim 12, and is rejected with the same rationale.
33. **In regard to independent claim 22**, the claim is directed to a user interface for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
34. **In regard to dependent claim 23**, the claim is directed to a user interface for performing the method of claim 8, and is rejected with the same rationale.

***Response to Arguments***

35. Applicant's arguments with respect to claims 1, 13 and 22 have been considered but are moot in view of the new ground(s) of rejection as described above.

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**Conclusion**

36. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,877,776	03-1999	Beaman et al.
• US-6,678,410	01-2004	Phinney et al.
• US-6,687,879	02-2004	Teshima et al.

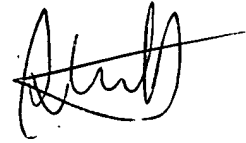
37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Gregory J. Vaughn  
May 18, 2005

A handwritten signature in black ink, appearing to read 'Stephen Hong', with a long horizontal stroke extending to the right.

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**